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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/916,453	07/27/2001	David J. Green	0325.00487	8728

21363	7590	06/02/2005

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EXAMINER
EHICHIOYA, FRED I

ART UNIT	PAPER NUMBER
2162	

DATE MAILED: 06/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/916,453	GREEN ET AL.
	Examiner	Art Unit
	Fred I. Ehichioya	2162

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *11 March 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1 - 20* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1 - 20,* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

1. In view of the Appeal Brief filed on 02 July 2004, PROSECUTION IS HEREBY

REOPENED. The rejection set forth below.

To avoid abandonment of the application, appellant must exercise one of the

following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply

under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied

by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130,

1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

2. After an Appeal Conference, Conferees decided to withdraw the finality of the

last Office Action and therefore, the finality of that action is withdrawn.

3. With respect to claims 1 – 20, detail action follows:

Response to Arguments

4. Applicants argue:

(a) "The non-statutory double patenting rejection of claim 1 over claim 1 of co-

pending Application No. 09/992,652 appears to be improper. The co-pending

application is not an issued patent and thus the double patenting rejection is

inappropriate per MPEP §804.I.A." (page 6, section VII. A. of argument).

(b) "Nowhere in the above text does Freeman appear to discuss storing a parameter that defines a program for a programmable logic device in a non-programming field of a file suitable for programming the programmable logic device" (page 9, paragraph 2 of argument)

Regarding the applicants' argument (a): Examiner respectfully disagrees with the applicants. "Double patenting may exist between a published patent application and an application filed by the same inventive entity, or by different inventive entities having a common inventor, and/or by a common assignee. Since the published application has not yet issued as a patent, the examiner is permitted to make a "provisional" rejection on the ground of double patenting" MPEP §804.I.C. Therefore the Double patenting rejection of last Office Action is proper.

Regarding the applicants' argument (b): Again Examiner respectfully disagrees with the applicants. First of all Examiner wishes to state that "Parameter" as defined by Microsoft Computer Dictionary, Fifth Edition, page 391, is a value that is given to a variable, either at the beginning of an operation or before an expression is evaluated by a program; Microsoft Computer Dictionary also defined "programmable logic device" on pages 277, 318 and 425 as "logic chip" or "integrated circuit"; and secondly, applicants disclose on pages 6 - 8 of the specification that the "fields within the comment lines may be non-programming or implemented as non-programming fields". Therefore examiner interprets the "comment line" as "non-programming field". With regard to the above definition and disclosures, examiner wishes to state that USPN 5,805,862 issued to Winter et al discloses storing "a parameter that defines a program for a programmable

logic device in a non-programming field" (see column 3, lines 60 – 61; "READ INPUT

ON PORTH" are parameters or variables stored on the comment line and Winter

discloses "integrated circuit" as "programmable logic device").

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created

doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the

unjustified or improper timewise extension of the "right to exclude" granted by a patent

and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11

F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225

USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA

1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*,

418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be

used to overcome an actual or provisional rejection based on a nonstatutory double

patenting ground provided the conflicting application or patent is shown to be commonly

owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a

terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with

37 CFR 3.73(b).

Claim 1 is rejected under the judicially created doctrine of obviousness-type

double patenting as being unpatentable over claim 1 of Co-pending application No.

09/992,652. Although the conflicting claims are not identical, they are not patentably

distinct from each other because they are substantially similar in scope and they use the

same limitations, using varying terminology.

The difference between claim 1 of '652 application and instant claim is that claim

1 of the instant application does not recite the term "compressing said programming

item to present a compressed item".

It would have been obvious to a person of ordinary skill in the art at the time the

invention was made to exclude the term "s compressing said programming item to

present a compressed item" because the person would have realized that the remaining

elements would have performed the same functions as before. The advantage of

compressing data is that it reduces the size of data such that it can be stored in less

space and can be transmitted with less bandwidth. "Omission of element and its

function in combination is obvious expedient if the remaining elements perform same

functions as before." See In re Karlson (CCPA) 136 USPQ 184, decide Jan 16, 1963,

Appl. No. 6857, U.S. Court of Customs and Patent Appeals.

Further a rejection based on nonstatutory double patenting is based on a

judicially created doctrine grounded in public policy so as to prevent the unjustified or

improper timewise extension of the right to exclude granted by a patent. In re

Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993).

The claim is provisionally rejected under the judicially created doctrine of double

patenting as being directed to the same invention as that set forth in claim 1 of

copending Application No. 09/992,652. See In re Thorington, 418 F.2d 528,163 USPQ

644 (CCPA 1969).

This is a <u>provisional double patenting</u> rejection because the claims have not in

fact been patented.

6. In view of the above, the examiner contends that all limitations as recited in the

claims have been addressed in this Office Action.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3, 5, 9, 10, 11, 13, 15, 19 and 20 are rejected under 35 U.S.C. 102(b)

as being anticipated by U.S. Patent 5,805,862 issued to Winter et al (hereinafter

"Winter").

Regarding claims 1, 11 and 20, Winter teaches a method of generating a file

suitable for programming a programmable logic device (see column 2, lines 31 – 33:

Winter discloses "programmable logic device" as "electronic circuit" or "integrated

circuit"), the method comprising the steps of:

(A) generating a programming item from a plurality of parameters that define a

program for said programmable logic device (column 2, lines 54 – 62: source code

which contains instructions stored in a file in this case is a "programming);

(B) storing said programming item in a programming field of said file in response

to generating (column 3, lines 38 – 47: in this case hexadecimal and decimal values are

the programming items stored in the memory); and

(C) storing at least one of said parameters in a non-programming field of said file

(column 3, lines 60 – 61: "READ INPUT ON PORTH" are parameters or variables

stored on the comment line; applicants disclose "comment line" as "non-programming

field" see response to argument (b) above).

Regarding claims 3 and 13, Winter teaches the step of second storing one of

said parameters in a second non-programming field of said file (see table III and column

5, lines 10 - 11).

Regarding claims 5 and 15, Winter teaches the steps of:

Generating an error detection item (column 4, lines 10 - 15); and

storing said error detection item in a second non-programming field of said file

(column 4, lines 16 - 17).

Regarding claims 9 and 19, Winter teaches the step of bracketing said

non-programming field with a pair of delimiters (see Table II and column 4, lines 65 -

67).

Regarding claim 10, Winter generating an error detection item (column 4, lines

10 - 15);

storing said error detection item is a second non-programming field of said file

(column 5, lines 10 – 11: column 4, lines 7 – 23 explains that these values are error

detection items);

storing another of said parameters in a third non-programming field of said file

(column 5, lines 12 - 13);

storing an identification item in a fourth non-programming field of said file (see

Table III, "comment-table[03]=......", the identification item stored in this field is "6033 fc

10 24"); and

bracketing a combination of said non-programming field, said second non-

programming field, said third non-programming field, and said fourth non-programming

field with a pair of delimiters (see Table II and Table III: Winter discloses "comment line"

as "non-programming field").

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of

the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

the various claims was commonly owned at the time any inventions covered therein

were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g)

prior art under 35 U.S.C. 103(a).

9. Claims 2, 4, 6, 7, 8, 12, 14, 16, 17 and 18 are rejected under 35 U.S.C. 103(a) as

being unpatentable over Winter in view of U.S. Patent 6,873,630 issued to Muller

et al (hereinafter "Muller").

Regarding claims 2, 4, 12 and 14, Winter discloses the claimed subject matter as

discussed in claims 1 and 11 respectively respectively. Winter also discloses comment

lines as non-programming fields (see response to argument (b) above). Tables II and III

show comment lines 1 – 4 or multiple comment lines that store parameters.

Winter does not explicitly frequency parameter as claimed.

However, Muller teaches storing a frequency parameter (see column 7, lines 18 -

20).

It would have been obvious to one of ordinary skill in the data processing art at

the time of the present invention to combine teaching of the cited references because

Muller's teaching of "storing a frequency parameter" would have allowed Winter's

system to transfer data to and from entity at multiple gigabits per second as suggested

by Muller at column 2, lines 11 - 14. The advantage is that this will allow the transfer

rate of data to exceed the network traffic of 1 Gbps (see also column 1, lines 60 – 67).

wherein writing error checking signal are the parameters stored in non-programmable field. The motivation is that the error checking signal is used to check whether the data fields generated during a particular communication are allowed or forbidden by a communication protocol.

Regarding claims 6 and 16, Muller teaches error detection item is a cyclic redundancy check checksum (see column 14, lines 20 - 24).

Regarding claims 7 and 17, Muller teaches cyclic redundancy check checksum is configured to detect a bit swap within said file (see column 14, lines 9 -12).

Regarding claims 8 and 18, Muller teaches the step of storing an identification item configured to identify said programmable logic device in a second non-programming field of said file (column 7, lines 54 - 57).
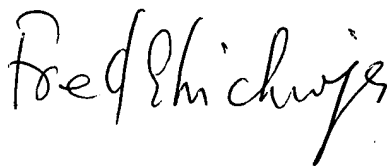
Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fred I. Ehichioya whose telephone number is 571-272-4034. The examiner can normally be reached on M - F 8:00 AM to 4:30 PM.
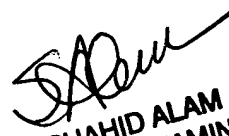
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E. Breene can be reached on 571-272-4107. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Fred I. Ehichioya
Patent Examiner
Art Unit 2162

May 31, 2005

SHAHID ALAM
PRIMARY EXAMINER